

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY C. CHESS

Appeal No. 2000-0304
Application No. 08/778,688

ON BRIEF

Before NASE, CRAWFORD, and BAHR, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 20, which are all of the claims pending in this application.

The appellant's invention relates to an intermediate for making repositionable or removable adhesive backed labels. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.

The prior art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Cross	4,863,772	Sep. 5, 1989
Stewart	5,482,328	Jan. 9, 1996

The rejection

Claims 1 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stewart in view of Cross.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer for the examiner's complete reasoning in support of the rejection (Paper No. 8) and to the brief (Paper No. 7) and reply brief (Paper No.9) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the

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examiner. As a consequence of our review, we make the
determinations which follow.

The rejection in this case is under 35 U.S.C. § 103.

Initially we note that when it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellant. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellant's invention. As in all determinations under 35 U.S.C. § 103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885,

1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann

Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). In determining obviousness/nonobviousness, an invention must be considered "as a whole," 35 U.S.C. § 103, and claims must be considered in their entirety. Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

The examiner is of the opinion that the Stewart reference discloses:

. . . a business form with a removable label comprising a first paper layer (60), a liner material layer (59), a permanent adhesive layer (80), a removable adhesive layer (82), and a second paper layer (12). [Examiner's answer at page 4].

The examiner, recognizing that Stewart does not disclose a permanent adhesive release material layer, relies on Cross for teaching of a permanent adhesive release material layer for use in a rolled intermediate and concludes:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the label stock of Stewart with the release material of Cross to enable the intermediate to be processed in a rolled configuration and easily unrolled when desired.[Examiner's answer at page 4].

The appellant argues that there is no teaching for utilizing non-highly calendered liner material in Stewart. In regard to the recitation in both independent claims 1 and 14 of a liner material having a non-highly calendered texture, the examiner states:

Stewart does not disclose a liner material having a non-highly calendered texture. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the label of Stewart with a non-highly calendered liner, since calendering is a well known process in the label art, and it would have been within the level of ordinary skill in the art to have provided a liner with an amount of calendering suitable for its end use. [Examiner's answer at page 4].

However, there is no disclosure in Stewart about the need for non-highly calendered liner material. In fact, the Stewart reference does not mention calendering of the liner at all. There is no evidence that the end use of the liner in the Stewart reference would require non-highly calendered liner material. As such, in our view, there is no suggestion to utilize non-highly calendered liner material in Stewart.

We have reviewed the disclosure of Cross and find that it does not cure the deficiencies noted above for the Stewart reference. Therefore, we will not sustain the rejection of claims 1 and 14 or claims 2 through 13 and 15 through 20 dependent therefrom.

The decision of the examiner is reversed.

REVERSED

JEFFREY V. NASE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MURRIEL E. CRAWFORD)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
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